REMARKS

Claims 1-7 and 15-28 are pending. In the Action mailed on September 29, 2006, the Examiner took the following action:

(1) rejected claims 22-28 under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement;

(2) rejected claims 22-28 under 35 USC § 112, second paragraph, as being indefinite; and

(3) rejected claims 1-7 and 15-28 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0072997 (Colson), in view of U.S. Patent Application Publication No. 2001/0047362 (Comroe).

Rejections under 35 U.S.C. § 112

The Action rejected claims 22-28 under 35 U.S.C. § 112, first and second paragraphs, as failing to comply with the enablement requirement and for being indefinite. In regard to § 112, first paragraph, the Examiner has asserted that "the computer readable media itself cannot perform an action or a method, therefore is it not clearly understood how the computer readable media would perform the method of claims 1-7 for claims 22-28, respectively." The rejections under § 112, second paragraph, are based substantially similar reasoning (pages 2-3 of Action).

Claims 22-28 have been respectively amended as indicated above to correct the language at issue under the § 112 rejections. Specifically, each of claims 22-28 has been amended to recite: "Computer readable media including one or more program modules configured to cause one or more processors to perform the method of claim...", wherein each claim depends from one of method claims 1-7, respectively. Support for the amendments to claims 22-28 is found at least at page 3, line 25 to page 5, line 16 of the Specification as originally filed. Applicant believes that the § 112 rejections have been full addressed by the amendments to claims 22-28 and respectfully requests that the § 112 rejections be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1-7 and 15-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colson in view of Comroe, as respectively cited above. Applicant respectfully traverses the rejections, as supported below.

Claim 1 recites a method for augmenting an internal library with published submissions to a technical society, the method comprising:

- locating an abstract for a published submission on a technical society website;
- downloading the abstract for the published submission to a machine readable memory medium at a first address;
- locating the published submission on a technical society website;
- downloading the published submission to the machine readable memory medium at a second address; and
- embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked.

Colson fails to teach or suggest <u>downloading the abstract for the published submission to</u> <u>a machine readable memory medium at a first address</u>, and <u>downloading the published</u> <u>submission to the machine readable memory medium at a second address</u>, as recited by the subject matter of claim 1. Also, Colson fails to teach or suggest <u>embedding a hyperlink to the</u> <u>second address into the abstract, the hyperlink being configured to display the published</u> <u>submission when invoked</u>, as recited by the subject matter of claim 1.

Rather, Colson is directed to a system for publishing respective product documents for clients on a web site of the Global Information Network (Abstract of Colson). A search engine at the web site permits users to seek and display documents published thereon (Abstract of Colson). Colson further comments that certain aspects of the published documents can be targeted by the search engine, including abstracts of the published documents (Para. 0080 of Colson). Furthermore, a user can opt to download an electronic copy of a document from the web site into the user's computer (Para. 0080 of Colson).

However, under the subject matter of claim 1, an abstract and the corresponding document are treated as discrete entities in order to permit downloading each to its own address (i.e., first and second, respectively). In contrast, Colson make no provision, teaching or suggestion that an abstract of a document is discretely downloadable at all, not the least of which being to a first address distinct from a second address. Also, Colson make no provision, teaching or suggestion regarding the embedding of a hyperlink to such a second address in the abstract. In view of the foregoing, it is abundantly clear that Colson fails to teach or suggest several features as positively recited by the subject matter of claim 1.

Comroe fails to cure the deficiencies of Colson. In particular, Comroe fails to teach or suggest downloading the abstract for the published submission to a machine readable memory medium at a first address, and downloading the published submission to the machine readable memory medium at a second address, as recited by the subject matter of claim 1. Also, Comroe fails to teach or suggest embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked, as recited by the subject matter of claim 1.

Rather, Comroe is directed to publishing a newsletter over a computer network by way of a web site (Abstract; Para. 0048 of Comroe). Under Comroe, numerous aspects of the newsletter can be displayed to a user (e.g., reader), including abstracts of the published articles (Abstract of Comroe). However, Comroe expresses no interest in *downloading* anything from the newsletter web site to a user. In fact, Comroe is completely lacking the term "download" or any of its respective equivalents, in any context. Thus, Comroe cannot teach or suggest the subject matter of claim 1.

There is no way to select elements from Colson, and then to somehow combine those elements with others selected from Comroe, in order to arrive at the subject matter as recited by claim 1, as no possible combination of Colson and Comroe teaches or suggests all of the required features and limitations. At the very least, Colson and Comroe – alone, or in any possible

combination – fail to teach or suggest: 1) downloading the abstract for the published submission to a machine readable memory medium at a first address; 2) downloading the published submission to the machine readable memory medium at a second address; and 3) embedding a hyperlink to the second address into the abstract, as recited by claim 1. The mutual deficiencies of Colson and Comroe render the § 103 rejection of claim 1 invalid in view of MPEP 2143.03.

In view of the foregoing, Applicant asserts that the § 103 rejection of claim 1 is unsupportable and should be withdrawn. Applicant further asserts that claim 1 is allowable.

Claims 2-7 and 22-28 depend (directly or indirectly) from claim 1 and are also allowable at least by virtue of their dependence. Furthermore, claims 2-7 and 22-28 are allowable for the patentably distinct subject matter that each recites.

Claim 15 recites a system for augmenting an internal library with published submissions to a technical society, the method comprising:

- a first means for locating an abstract for a published submission on a technical society website;
- a second means for downloading the abstract for the published submission to a machine readable memory medium at a first address;
- a third means for locating the published submission on a technical society website;
- a fourth means for downloading the published submission to the machine readable memory medium at a second address; and
- a fifth means for embedding a hyperlink to the second address into the abstract, the hyperlink being configured to display the published submission when invoked.

For reasons substantially the same as those argued above in regard to claim 1, claim 15 is allowable over any combination of Colson and Comroe. Specifically, neither Colson nor Comroe teaches or suggests a second means for downloading the abstract for the published submission to a machine readable memory medium at a first address, a fourth means for downloading the published submission to the machine readable memory medium at a second address, and a fifth means for embedding a hyperlink to the second address into the abstract, the

hyperlink being configured to display the published submission when invoked, as positively recited by the subject matter of claim 15.

In view of the foregoing, Applicant asserts that the § 103 rejection of claim 15 is unsupportable and should be withdrawn. In turn, Applicant asserts that claim 15 is allowable.

Claims 16-21 depend (directly or indirectly) from claim 15 and are also allowable at least by virtue of their dependence. Furthermore, claims 16-21 are allowable for the patentably distinct subject matter that each recites.

CONCLUSION

For the foregoing reasons, Applicant respectfully submits that pending claims 1-7, 15-28 are now in condition for allowance. If there are any remaining matters that may be handled by telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,

Dated: _Feb. 27, 2007_   By: _____
                                     Dale C. Barr
                                     Lee & Hayes, PLLC
                                     Reg. No. 40,498
                                     (206) 315-7916